REMARKS

1.) Claim Amendments

Applicants have amended [a] claims 7 and 19-20 to better claim the invention, [b] claim 8 in response to the Examiner's rejection and [c] claims 14 and 21 for cosmetic reasons. Also, claim 11 is canceled and the canceled subject matter is incorporated into the amended claim 8. Accordingly, claims 1-10 and 12-23 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 102(e)

Claims 1-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by International Publication No. WO 99/16266 having Forslow as an inventor (hereinafter "Forslow"). To support such rejection, Forslow must disclose every element of the invention as claimed. More particularly, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). With this requirement in mind, Applicants respectfully submit that Forslow fails to disclose every element of the invention as specified in each independent claim.

In general, the present invention is directed to a hybrid network having [1] all-services carrier for supporting real and non-real time services and [2] best-effort carrier for supporting only non-real time services. Since two carriers are available, the present invention requires a handset being operatively coupled to this hybrid network to select which carrier it will "camp" on and use as the default carrier during its idle state. However, the mobile station does not always have to use the default carrier and, if appropriate, may synchronize with the remaining carrier so that a certain type of call could be connected between the mobile station and the hybrid network. For example, if the mobile station "camps" on the all-services carrier, which is the selected default

carrier, and there is an incoming data call, the mobile station would synchronize with the all best-effort carrier, the incoming data call would be connected between the mobile station and the hybrid network using the best-effort carrier and, after the data call is completed, *the mobile station needs to and will synchronize or re-synchronize with the all-services carrier* per requirement that it has to "camp" on the selected default carrier during its idle state.

Regarding independent claim 1, Forslow, for example, fails to disclose the claim limitation of "*synchronizing a mobile station to a default carrier.*" Forslow in general focuses on determining whether a circuit-switched or packet-switched bearer should be established for a particular application flow. Such determination may be based on a requested quality of service. For example, a circuit-switched bearer may be allocated if the application flow requests real-time service and a packet-switched bearer may be allocated if the application flow requests non-real time service. Once the proper bearer is determined, a call can be established for the application flow. *See, e.g., Forslow, Abstract* and *page 27, lines 15-21.* Forslow is different from the present invention because it does not require the selection of a default carrier. *In fact,* Forslow teaches away from such selection because Forslow, to avoid setup time, prefers the mobile station establishing a connection with a communications network "through an authenticated, packet switched tunnel" and *not* establishing the connection "by using a dial-out, circuit switched connection." *Forslow, page 15, lines 14-20.* As a result, the mobile station will synchronize to the packet-switched network after being powered ON and thus there is no need to select a default carrier for synchronization.

In the Office Action, the Examiner suggests that page 9, lines 1-11 and page 11, lines 11-17 of Forslow disclose the claim limitation of "*synchronizing a mobile station to a default carrier.*" This is incorrect because such pages discuss how to select which bearer as an optimal bearer to use for an incoming call after the mobile station already synchronized with the network.

In addition, Forslow also fails to disclose the claim limitation of "*synchronizing the mobile station to the default carrier upon completion of the call.*" Forslow is different from the present invention because it does not require the mobile station to camp on a particular carrier. Upon completion of a call, Forslow releases the bearer associated

with such call so that it could again determine which bearer is an optimal bearer for a next incoming call. *Forslow, page 30, line 15 through page 31, line8.* Thus, Forslow is silent on the claim limitation of "*synchronizing the mobile station to the default carrier upon completion of the call.*" *In contrast*, the present invention does require the mobile station to camp on the default carrier and thus upon completion of the call, the mobile station is required to re-synchronize with the default carrier.

In the Office Action, the Examiner suggests that page 24, lines 3-5 of Forslow discloses the claim limitation of "*synchronizing the mobile station to the default carrier upon completion of the call.*" This is incorrect because such page discusses how to select which bearer as an optimal bearer to use for an incoming call and thus has nothing to do with mobile station performance after the call is completed.

Accordingly, claim 1 is believed to be patentably distinguishable over Forslow based on the above discussion. Claims 2-7 are also believed to be patentably distinguishable over Forslow for reasons similar to those discussed above for claim 1.

Furthermore, claims 5 and 7 also contain additional patentable features because Forslow does not disclose their limitations. Regarding claim 5, an active voice call over the default carrier is placed on hold during the time the mobile station is synchronizing with the remaining carrier such as a HDR carrier to connect an incoming data call. *In contrast*, if there is an incoming data call while a circuit-switched call is still established between the mobile station and the network, Forslow prefers to receive such incoming data call by also using the circuit-switched bearer even though the incoming data call is better suited for the packet-switched bearer. *Forslow, page 30, lines 8-23.* This seems to suggest that Forslow either [a] does not place an active circuit-switched call on hold while trying to connect an incoming data call using the packet-switched bearer or carrier or [b] teaches away from placing such active circuit-switched call on hold while trying to connect an incoming data call using the packet-switched bearer or carrier. Regarding claim 7, the discussion for claim 5 applies. In addition, Forslow simply is silent on the limitation of "*reconnecting the active voice call.*"

Accordingly, Applicants believe the limitations of claims 5 and 7 are themselves additional patentable features. If the Examiner believes otherwise, Applicants respectfully request the Examiner to provide prior art disclosing such limitations

especially because the current Office Action does not specifically discuss why claims 5 and 7 are rejected except due to their dependency on claim 1.

Regarding the amended independent claim 8, the canceled limitations of claim 11 are incorporated therein in response to the Examiner's rejection. Applicants respectfully submit that Forslow does not disclose these limitations especially because the current Office Action fails to point out where in Forslow such claim limitations are disclosed. The same is true for claims 12-13 and thus Applicants respectfully submit that the limitations of claims 12-13 are themselves additional patentable features. If the Examiner believes otherwise, Applicants respectfully request the Examiner to provide prior art disclosing these limitations.

Accordingly, claim 8 and 12-13 are believed to be patentably distinguishable over Forslow. In addition, claims 9-10 are also believed to be patentably distinguishable over Forslow for reasons similar to those discussed above for claim 8.

Regarding independent claim 14-20, they are believed to be patentably distinguishable over Forslow for reasons similar to those discussed above for claim 1. In addition, Applicants respectfully submit that claims 18 and 20 contain additional patentable subject matter for reasons similar to those discussed above for claims 5 and 7, respectively. Furthermore, Applicants respectfully submit that claim 19 also contain additional patentable subject matter especially because the current Office Action fails to point out where in Forslow the limitations of claim 19 are disclosed.

Regarding claims 21-23, they are believed to be patentably distinguishable over Forslow because the Examiner fails to point out where in Forslow such claim limitations are disclosed. In fact, the Examiner did not even discuss why claims 21-23 are rejected. If the Examiner believes otherwise, Applicants respectfully request the Examiner to provide prior art disclosing these claim limitations.

CONCLUSION

Claims 1-10 and 12-23 are presently standing in this patent application. In view of the foregoing remarks, each and every point raised in the Office Action mailed on April 24, 2003 has been addressed on the basis of the above remarks. Applicants believe all of the claims currently pending in this patent application to be in a condition for allowance. Reconsideration and withdrawal of the objections and rejections are respectfully requested. However, should the Examiner believe that direct contact with Applicants' attorney would advance the prosecution of the application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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